

REMARKS

The above-referenced application was filed on November 16, 2001, as a continuation-in-part of U.S. Patent Application Serial No. 09/711,017, filed on November 13, 2000. The application as filed included twenty-five claims. Claims 11-25 have been withdrawn from consideration.

In the outstanding Office action, claims 1-3 and 5-9 were rejected as anticipated under 35 U.S.C. § 102(b). In addition, claims 4 and 10 were rejected as obvious under 35 U.S.C. § 103(a). By way of this amendment, the rejected claims have been amended to more clearly distinguish the claimed subject matter over the cited art. Accordingly, claims 1-25 remain pending, with claims 1-10 being at issue. Reconsideration and allowance of all claims are requested.

I. The 35 U.S.C. § 102 (b) Rejections Are Overcome

The Examiner rejected claims 1-3 and 5-9 under 35 U.S.C. § 102(b) as being anticipated by Hurh, U.S. Patent No. 4,988,656 (hereinafter "'656"). Applicants respectfully submit that the '656 reference fails to disclose each and every element of claims 1-3 and 5-9 and, therefore, fails to anticipate these claims.¹

Independent claim 1, and those claims dependent thereon, specify, *inter alia*, a dispenser having retention walls mounted in the first and second ends of the base, the retention walls extending at an angle from the bottom wall into the interior channel, the retention walls each including an aperture adapted to receive an end of a roll of wound film.

The '656 reference fails to disclose each and every such element and thus, fails to anticipate the claims. '656 discloses a roll restraining dispensing carton, wherein the opposite ends of the carton include collars or retention walls for retaining the roll within the carton. As shown best in FIG. 7, the retention walls of '656 (26c) extend at an angle into the interior of the carton. However, as shown best in FIGS. 3 and 7, and in contrast to the present disclosure, the retention walls of '656 (26c) are extensions of the back wall (22) of the carton, rather than the bottom wall (16), as recited in amended claim 1.

¹ "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Rockwell Int'l Corp. v. United States*, 47 U.S.P.Q. 2d 1027 (Fed. Cir. 1998).

The Examiner further asserts that the dispenser of '656 teaches "a back wall 16 having a major flap 12 and a front wall 34 having a minor flap 36." (Office action, page 2.) Contrary to the Examiner's assertion, and contrary to the present invention, '656 teaches a dispenser having side panels or major flaps 12 extending from the bottom wall 16 and side flanges or minor flaps 36 extending from the top wall 34. Alternatively, the instant application teaches major 80 and minor 82 flaps extending from the back 38 and front 36 walls, respectively. The Examiner also states that "the Hurh dispenser is a handheld device usable in several different orientations, and thus there is much leeway in what one might consider to be the bottom, front and back sides." (Office action, page 2-3.) Applicants respectfully disagree with this characterization of the dispensers of both '656 and the present disclosure, as the walls of each dispenser are explicitly described and illustrated in their respective specifications. Moreover, Applicants submit that such a rejection is not grounded in the fundamentals of patent law. As indicated above, anticipation requires the disclosure of each element in a single reference. Such is not the case here, and "leeway" is not an appropriate basis from which to fill in the gaps of the prior art.

In light of the above-described distinctions, Applicants respectfully submit that claim 1, as well as those claims dependent thereon, cannot be anticipated by the '656 reference and, therefore, the rejection should be withdrawn.

II. The 35 U.S.C. § 103 (a) Rejections Are Overcome

The Examiner rejected the remaining claims, *i.e.*, claims 4 and 10, under 35 U.S.C. § 103(a) as unpatentable over '656. Reconsideration and withdrawal of this rejection is requested in view of the following remarks.

The remaining claims specify a wedge-shaped side flap and a die-cut single ply chipboard material. However, each claim is dependent on the above-referenced independent claim 1, and this rejection of such claims as obvious over the same anticipatory art is misplaced.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine the teachings of a plurality of references. Finally, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's own disclosure. *See In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See also* MPEP § 2143.

The examiner bears the burden of establishing a *prima facie* case of obviousness and "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To support a conclusion that a claimed combination is obvious, either: (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See In re Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). If the teachings of various references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *See In re Young*, 18 U.S.P.Q.2d 1089 (Fed. Cir. 1991).

As indicated above, '656 discloses retention walls (26c) extending at an angle from the back wall (22) of the carton into the interior of the carton.

The Examiner asserts that it would have been obvious to one having ordinary skill in the art to have made the angled bracing flap of '656 in a wedge shape and to use single-ply chipboard as the material for the dispenser. However, such assertions are irrelevant given the fact that '656 alone does not disclose or suggest all the elements required by the independent claim from which the claims at issue depend. As a result, at least the first criteria of MPEP § 2143 is not met and, thus, '656 cannot render the claims obvious. Specifically, '656 does not disclose a carton having retention walls that extend from the bottom wall of the carton, as recited in amended claim 1, and required by dependent claims 4 and 10.

In light of the foregoing, a *prima facie* case of obviousness has not been established and the associated rejection should, therefore, be withdrawn.

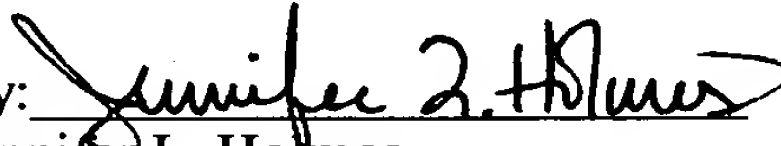
CONCLUSION

For the foregoing reasons, reconsideration and withdrawal of the rejections, and allowance of all pending claims are requested.

Should the Examiner wish to discuss the foregoing, or any matter of form or substance in and effort to advance this application to allowance, he is urged to contact the undersigned attorney.

Respectfully submitted,

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